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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,743	01/27/2004	Nicole M. Weiss	UM-08483	1087

7590 01/30/2007
David A. Casimir
MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/765,743

Applicant(s)

WEISS, NICOLE M.

Examiner

Kim M. Lewis

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 ad 10-12 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date h/b
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☒ Other: Detailed Action

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 7/7/06 has been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

Drawings

2. The drawings were received on 7/7/06. These drawings are approved by the examiner.

Response to Amendment

3. The amendment filed on 7/7/06 has been received. No claim has been amended.

Applicant's arguments presented in the amendment with respect to claims 1-12 have been reviewed. The examiner agrees with applicant's argument that the combination of Rubin and Bonutti does not lead to applicant's invention. Thus, the 103 rejections in the office action of 4/4/06 have been withdrawn. Applicant's attention is, however, directed to the new rejections that follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 2003/0105416 ("Hepburn et al.").

As regards claims 1-7 and 10-12, Hepburn et al. disclose a supinator/pronator therapy system that either explicitly or inherently anticipates all features of the claimed invention. More specifically, Hepburn et al. disclose an orthotic forearm device (10) comprising an upper portion (23) configured to attach to an upper arm, a lower portion (constituted by wrist stabilizer 18) configured to attach to a forearm¹, and a rotation component (comprising elements 50), positioned around said lower portion, wherein said rotation component is configured to exert static progressive stretch upon a forearm contained in said lower portion, wherein said static progressive stretch comprises supinated static progressive stretch and pronated static progressive stretch ((Abstract para. 36, 57 and 61). Applicant should note that device is capable of serving as a stretching splint, or as a free motion brace.

As regards claim 4, Hepburn et al. inherently disclose the orthotic forearm device of Claim 1, wherein said lower portion comprises a mechanical axis, wherein said forearm comprises an anatomical axis, wherein said mechanical axis matches the anatomical axis of said forearm (note Fig. 1).

¹ Applicant should note attached Exhibit A, wherein the popular use of the term forearm is defined as the portion of the arm from the shoulder to the hand.

As regards claims 10-12, Hepburn et al. disclose a method of treating a forearm disorder, comprising, providing the orthotic device of Claim 1 (note the rejection of claim 1 above), fitting said orthotic device upon a forearm (constituted by donning the device) and exerting static progressive stretch upon said forearm (note the abstract. Applicant should note that the limitations: an upper portion, a connecting component, a lower portion, and a rotation component, wherein said rotation component is configured to exert said static progressive stretch upon said lower portion are addressed in the rejection of claim 1 above. Moreover, applicant should note that the connecting component connects said lower portion and said upper portion (note Fig. 3 and page 2, para 35, specifically the recitation re. Fig. 3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hepburn et al.

As regards claims 5-7, Hepburn et al. disclose the orthotic device of claim 1, but fail to teach the orthotic forearm device of Claim 1, wherein said upper portion and said lower portion comprise a thermoplastic coating, wherein said thermoplastic coating comprises polyethylene plastic, and wherein said polyethylene plastic is greater than 3/16 inch thick.

Absent a critical teaching and/or a showing of unexpected results derived from providing the upper and lower portion of the device with a 3/16 inch thick polyethylene plastic coating, the examiner contends that such a coating is an obvious design choice which does not patentably distinguish applicant's invention. Moreover, it has been held that a selection of a known material based upon its suitability for the intended use is a design consideration within the level of ordinary skill in the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Allowable Subject Matter

9. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

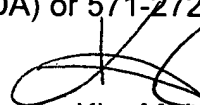
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-

Art Unit: 3772

4796. The examiner can normally be reached on Monday to Friday, from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.




Kim M. Lewis
Primary Examiner
Art Unit 3772

kml
January 20, 2007

Exhibit A

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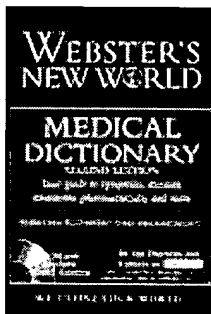
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MedicineNet Authored Definition of Forearm

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Forearm: The portion of the upper limb from the elbow to the wrist.

In popular usage, the arm extends from the shoulder to the hand. However, in medical terminology, the arm refers to the upper extremity extending from the shoulder only to the elbow. The arm is thus distinguished in medical usage from the forearm, which extends from the elbow to the wrist.

MedTerms Medical Word The forearm has 2 bones: the radius and ulna.

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tendinitis, olecranon bursitis, fractures, sprains, arthritis, cellulitis, tumors, and ulnar nerve entrapment. Inflammation, redness, warmth, swelling, tenderness, and decreased range of motion are other symptoms associated with elbow pain. Treatment for elbow pain depends upon the nature of the patient's underlying disease or condition.

Source:MedicineNet

- [Elbow Pain -- Star Pitcher Out -](#)

Source:MedicineNet

- [Tennis Elbow -](#)

Source:WebMD

Medical Reference from The Cleveland Clinic

- [Tuberculosis Skin Test \(PPD Skin Test\) -](#) The tuberculosis skin test (also known as the tuberculin or PPD test) determines whether a person has developed an immune response to the bacterium that causes tuberculosis (TB). Learn how the test is administered, how a reading is obtained, and how the results are interpreted.

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